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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,642	01/20/2004	Mark Horton	30,800-00US	5319

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/762,642

Applicant(s)

HORTON, MARK

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/20/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "finger ridge portions", of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Larson (3,286,349).

In regards to claim 1, Larson discloses the same invention including a cutting device (1) having a cutting wheel (3), a handle (7) having a finger stop structure (5a), and a neck portion coupled to the cutting wheel and handle (2), and the neck portion has a length greater than or equal to the diameter of the cutting wheel (2).

In regards to claim 10, Larson discloses the handle is formed of plastic (Column 1 lines 40-45).

In regards to claim 11, Larson discloses one or more finger ridges on the handle (7b).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Riley (5,491,898). Larson discloses the invention including the finger stop is an elongate pad extending along a top surface of the handle (5a).

However, Larson fails to disclose the finger stop is made of rubber. Riley teaches to make portions of a handle out of rubber (Column 4 lines 54-57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with a stop made from rubber, as taught by Riley, to prevent the user's hand from slipping while in use.

6. Claims 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Arend et al. (6,044,565). Larson discloses the invention however, Larson remains silent on the specific dimensions of the cutting apparatus and, therefore, fails to disclose, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1, the length of the handle is approximately 6 inches, and the diameter of the cutting wheel is approximately 2 to 3 inches.

It is noted that the term "approximate" means very similar (The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim 4, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 (6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to claims 6-8, Arend et al. teaches the length of the handle is approximately 6 inches (Column 3 line 10, 6.25 inches is approximately 6 inches). In regards to claim 9, Arend et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with specific dimensions/ratios, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Hawkins (5,428,898). Larson discloses the invention but fails to disclose the neck portion has an arcuate shape.

Hawkins teaches a neck portion with an arcuate shape (27). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with an arcuate neck portion, as taught by Hawkins, to allow the shape of the apparatus to cooperate with the natural twisting of the users wrist while applying a normal force to cut the work piece, thereby, allowing for a more efficient cutting apparatus.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Hawkins and Riley. Larson discloses the invention including, in regards to claim 12, a cutting wheel (3), a handle made of a first material and having a top surface along a first end (7), a finger stop structure connected to the top surface along the first end (5), the finger stop structure made from a slip-resistant material (5a), a neck coupling the cutting wheel to the first end of the handle (2), and the length of the neck is greater than the diameter of the cutting wheel (2). In regards to claim 13, Larson discloses the finger stop structure includes an elongate pad made of slip-resistant material (5a).

However, Larson fails to disclose the finger stop is made of a second material and the neck portion is arcuate.

Riley teaches adding a second non-slip material to a portion of a handle designed to encounter the fingers of the user (Column 4 lines 54-57). Therefore, it

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would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with a stop made from a second non-slip material, as taught by Riley, to prevent the user's hand from slipping while in use.

Hawkins teaches a neck portion that is arcuate (27). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with an arcuate neck portion, as taught by Hawkins, to allow the shape of the apparatus to cooperate with the natural twisting of the users wrist while applying a normal force to cut the work piece, thereby, allowing for a more efficient cutting apparatus.

9. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson in view of Riley and Hawkins as applied to claim 12 above, and further in view of Arend et al. Larson, Hawkins, and Riley disclose the invention however, Larson, Hawkins, and Riley remain silent on the specific dimensions of the cutting apparatus and, therefore, fails to disclose, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 and the diameter of the cutting wheel is approximately 2 to 3 inches.

It is noted that the term "approximate" means very similar (The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim 15, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 (6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to claim 14 and 16, Arend et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). Therefore, it

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would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson in view of Riley and Hawkins with specific dimensions/ratios, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arend et al. in view of Hawkins. Arend et al. discloses the invention including providing a cutting device having a cutting wheel (6) and a handle (31), the handle having a length of between 4.5 and 7 inches (Column 3 lines 7-11), the handle having a finger stop (Fig. 2B round projection directly above reference numeral 34), grasping the handle of the cutting device with one end of the cutting device being held entirely within the palm of the user's hand (Column 3 lines 49-58 continued to Column 4 lines 1-4) and one surface of the handle engaging a substantial portion of the user's index finger (3), and a tip of the index finger engaging the finger stop (4) and rolling the cutting wheel across an item to cut the item (Title).

However, Arend et al. fail to disclose the item to be cut is a food item. Hawkins teaches that it is old and well known for a hand held rotary cutter to cut a food item (Title). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Arend et al. with the method of cutting food items, as taught by Hawkins, to provide an additional intended use for the apparatus.

### ***Conclusion***



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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Garret, Larson ('335), Benedict, Smith, Henry et al., Wallays, Ming, Rather et al., and Chen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 26, 2005



Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700